

Remarks

The Office has required restriction in the present application as follows:

- Group I: Claims 1-10, 17-21, 25 and 26, drawn to a soft magnetic powder a majority of particles of which has not greater than ten crystal particles on average in its cross section, a metal body from said magnetic powder and a method of making a metal body from said powder;
- Group II: Claims 11-14, 23 and 24, drawn to a method of treating a soft magnetic powder comprising heating a soft magnetic powder whereby the number of crystal particles in each of the powder particles is reduced;
- Group III: Claim 15, drawn to a method of coating a soft magnetic iron alloy powder comprising selectively oxidizing the alloying element in the powder, applying a phosphoric acid on the surface of the metal particle and drying; and
- Group IV: Claim 16, drawn to a method of coating a soft magnetic metal powder, comprising preparing a soft magnetic metal powder each particle of which has no greater than ten crystal grains on average in its cross section, coating a higher resistive material on the outer surface of the soft magnetic metal powder by mechano-fusion of the higher resistive material and the soft magnetic metal powder, applying a liquid comprising a phosphoric acid on the outer surface of the soft magnetic metal powder and drying.

The Office has characterized the inventions of Groups II and I as related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the process as claimed can be used to make “another and materially different product such as for example a soft magnetic powder having any number of crystal grains” and the product as claims can be made by “another and materially different such as for example a process wherein a soft magnetic material is ground to powder having a size wherein the resulting powder has no greater than ten crystal grains in its cross section.” The Office has made an unsupported conclusion. Applicants respectfully submit if the claimed process can be used to make the “soft magnetic powder having any number of crystal grains”, the Office has not shown that the alleged product is materially different from the claimed product. Further, the Office has

not shown that even if, the alleged “grinding” process can be used to make the claimed product, that “grinding” process is materially different from the claimed process.

Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement.

The Office citing MPEP §802.01 states that Groups I–IV are distinct. However, the office has not provided any explanation and/or examples, and merely stated a conclusion. Accordingly, Applicants respectfully request withdrawal of the Requirement for Restriction.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application. Applicants note that Groups I–V are classified in class 148, and respectfully submit that a search of all the claims would not impose a serious burden on the Office.

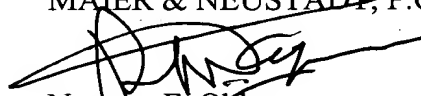
Finally, the Applicants note that MPEP §821.04 states, “if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.” Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the requirement for restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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